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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,781	08/27/2001	Theresa L. McGuire	10992766-1	6757

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EXAMINER

VUONG, JASON DUY ANH

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,781

Applicant(s)

MCGUIRE ET AL.

Examiner

Jason D. A. Vuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04-01-2003</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1, 2, 3, 5, 7 and 16** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,421,135 B1 to Fresk et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding **Claim 1**, Fresk et al. disclose a method for scanning a job on a document-processing device when a print path is not available (Column 13 Lines 56-61), the device having a printer job channel (the Print Processor disclosed by Fresk et al., Element 23 of Figure 6, is equivalent to the claimed printer job channel because,

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according to the instant application, the printer job channel is a component that provides access to the print path and the print engine. Refer to the Specifications, Page 9 Line 10), the method comprises:

upon initiating a job, determining that a printer job channel is not available (refer to Column 13 Lines 56-61);

scanning the job (refer to Column 13 Line 59);

spooling the job to a mass storage device (refer to Column 13 Line 60); and

storing the job in the mass storage device until the printer job channel becomes available (refer to Column 13 Lines 60-61).

Regarding **Claim 2**, wherein initiating a job includes user input on a control panel on the device (Fresk et al. disclose that a user can start a job via the user interface. Refer to Column 5 Lines 25-27, and Column 8 Lines 64-65).

Regarding **Claim 3**, wherein initiating a job includes triggering a media sensor on the device (Fresk et al. disclose that a sensor can be used to start a job via the user interface. Refer to Column 5 Lines 25-27, and Column 10 Lines 62-67 and Column 11 Lines 1-5).

Regarding **Claim 5**, wherein spooling the job to a mass storage device includes storing the job as a data file (Fresk et al. disclose that the entire document is stored to disk. Refer to Column 13 Lines 59-60).

Regarding **Claim 7**, wherein the mass storage device is a non-volatile memory (Fresk et al. disclose that a disk is used to store image data. Hard disk drives are inherently known as non-volatile memory devices. Refer to Column 13 Line 60).

Regarding **Claim 16**, this claim is essentially the same as **Claim 1** above, but implemented as computer program codes embedded in a medium readable by a computer or an electronic device. Therefore it is rejected based upon the rejection of **Claim 1** above. Further it is inherent that computer program codes must reside within the ROM or RAM section (serves as readable medium) of the system disclosed by Fresk et al. (see Figure 1 Element 100, Figure 3 Elements 11 and 15, and Figure 5 Elements 34 and 36) to implement or realize the functions or methods (determine if print path is available, save scanned images of print path is unavailable, print the scanned images when the print path is available) of their invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,026,258 to Fresk et al. in view of U.S. Patent No. 6,469,795 B2 to Beaudet et al.

Regarding **Claim 4**, Fresk et al. fail to disclose a method of requesting user input selecting whether to proceed with the job upon determining that a printer job channel is not available.

Beaudet et al., however, disclose a method of requesting user input selecting whether to proceed (user can select the option of setting up the copy job. See Figure 4D) with the job upon determining that a printer job channel is not available (see Figure 4D).

Therefore it would have been obvious to one skilled in the art to combine Fresk et al.'s features (features of **Claim 1**) with Beaudet et al.'s feature (user selectable option). The motivation to do so is to allow the user to confirm his or her selection, and it also allows the user to cancel the selection if he or she changes the decision (by simply not selecting the option).

3. **Claims 5, 8, 10, 11, 12, 13, 14, 15 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,026,258 to Fresk et al.

Regarding **Claim 6**, although Fresk et al. do not explicitly mention that the mass storage device (disk) is a volatile memory, it is clear from the disclosure that the storage

device can be volatile memory (RAM, or ROM. Refer to Column 6 Lines 15-21). Also, it is well known and expected in the art that mass storage devices can be either volatile or non-volatile memory devices.

Regarding **Claim 8**, Fresk et al. do not explicitly show a method of periodically checking the status of the printer job channel and printing the job if the channel is available. A method of printing the saved document is disclosed (refer to Column 13 Lines 59-61). Hence, it is clear that a method of some sort is used to check the status of the printer (whether it be polling or interrupt) to find out whether the print channel is available or not.

Regarding **Claim 10**, Fresk et al. disclose a document-processing device (see Figure 1 Element 100) which is configured to concurrently scan a first job and print a second job (refer to Column 13 Lines 58-61), the device comprising:

- a copy module configured to scan a first job to produce scanned images of the first job (refer to Column 13 Lines 58-61, and also see Figure 1 Element 60),
- a mass storage device coupled with the copy module (see Figure 3 Element 10. Mass storage device is connected to Element 50, and Element 50 is connected to the copy module as illustrated in Figure 2); and
- a printer module coupled with the copy module (Figure 2 Element 50 is connected to Element 60), the printer module having a controller configured to temporarily direct the scanned images to the mass storage device when the

printer module is otherwise engaged (although Fresk et al. do not explicitly teach or disclose such printer controller, it is clear that the print controller is controlling the entire image forming device, and therefore it is in charge of directing the scanned images to disk).

It is well known and expected in the art that the main job of the print controller is to get the image data and figure out how it's going to put everything on the paper or save it to disk (save to disk feature disclosed by Fresk et al.). Therefore it would have been obvious that the print controller is directing the scanned images to the mass storage device or disk.

Regarding **Claim 11**, it is clear that the mass storage device is integral with the printer module (see Figure 3 Element 10).

Regarding **Claim 12**, it is also clear that the mass storage device is integral with the copy module because the scanned documents are directed to the mass storage device while the print engine is engaged or unavailable (see Figure 3 Element 10, and Figure 2).

Regarding **Claim 13**, the controller is configured to automatically retrieve the scanned images from the mass storage device when the printer module is not otherwise engaged (Fresk et al. disclose on Line 60 of Column 13 that the scanned document is spooled after the print job completes. Since the print controller is in charge of the entire

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image forming device, it is clear that the print controller automatically retrieves the scanned document).

Regarding Claim 14, the mass storage device is a non-volatile memory device (see Figure 3 Element 10).

Regarding Claim 15, the mass storage device is a storage disk (see Figure 3 Element 10).

Conclusion

Any inquiry concerning this communication or earlier communications should be directed to Jason Vuong at 703-306-4157. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863

If attempts to reach the examiner by telephone are unsuccessful, the examiner's trainer, Joseph Mancuso can be reached at 703-305-3885.


MADELEINE NGUYEN
PATENT EXAMINER

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